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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,277	06/15/2001	Markus Lautenbacher	P01,0200	7143
26371	7590	03/23/2006		
FOLEY & LARDNER LLP 777 EAST WISCONSIN AVENUE SUITE 3800 MILWAUKEE, WI 53202-5308			EXAMINER NAWAZ, ASAD M	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/868,277

Applicant(s)

LAUTENBACHER, MARKUS

Examiner

Asad M. Nawaz

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16-20 and 24-29 is/are pending in the application.
- 4a) Of the above claim(s) 27-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-20 and 24-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the election filed on 12/16/05. Claims 16-20 and 24-26 were elected and claims 27-29 have been withdrawn from consideration.

Accordingly, claims 16-20 and 24-26 are pending.

### ***Election/Restrictions***

2. Applicant's election with traverse of claims 27-29 is acknowledged. The traversal is on the ground(s) that although the claimed subject matter may be classified in different classes, the inventions are not independent. This is not found persuasive because the two groups are separately usable. Furthermore, the applicant has not explicitly stated the reasoning behind the traversal but simply has stated that if the examiner is aware of another method as claimed, using a method which is materially different from that set forth in claims 27 and 28...".

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Objections***

3. Claim 16-20 objected to because of the following informalities: The system within an IP based network comprises a server and a terminal having access to the IP-based network. As currently written, the terminal could simply access itself for services. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 16-20 and 24-26 are rejected under 35 U.S.C. 103(a) as being anticipated by Devarakonda et al (US Patent No. 6,757,729) further in view of Brocker et al (USPN: 5,365,606).

As to claim 16, Devarakonda teaches In an IP-based network, a system comprising: at least one server storing application programs for implementing user specific subscribable services, said server storing said services on a per user basis; (Abstract; Fig 1; col 2, 28-40; col3, 50-56; col 4, 1-5 and 38-40)

And at least one terminal having on-demand access to said IP-based network for requesting downloadable programs corresponding to said services, whereby said application programs can be executed. (Fig 1; col 4, 43-44; col 6, 4-8)

However, Devarakonda does not explicitly indicate that the application execution environment is being ported to the terminal only once.

Brocker et al teaches a virtual software machine that runs multiple program modules in a single address space of a target computer. Thus the application execution environment is ported only once to the terminal (col 1, lines 62 to col 2, line 13).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Brocker into those of Devarakonda to make the system to make the system more efficient. Such a system would reduce operating system resource consumption and increase transaction time (col 1, lines 56-57).

Claims 24 presents no new limitations above claim 16 above and is thus rejected under similar rationale.

As to claim 17, Devarakonda teaches the system of claim 16, wherein said user specific subscribable services are supplementary to basic user services. (col 3, 50-56; col 4, 51-67; col 5, 10-24)

As to claim 18, Devarakonda teaches the system of claim 16, wherein said user specific subscribable services are supplementary to Internet Telephony service.(col 4, 11-15)

As to claim 19, Devarakonda teaches the system of claim 18, wherein said user specific subscribable services can be user configured via said at least one terminal.(Fig. 1; Fig. 4; col 3, 40-49)

As to claim 20, Devarakonda teaches the system of claim 19, wherein said server includes a Java system, and said at least one terminal supports downloading of said applications programs.(col 2, 20-23 and 49-61; col 3, 3-10; col 4, 44-47)

As to claim 25, Devarakonda teaches the terminal of claim 24, wherein said application execution component is implemented as a virtual machine. (abstract)

As to claim 26, Devarakonda teaches the terminal of claim 25 wherein said user subscribable services can be configured via said client component. (col 3, lines 39-61)

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asad M. Nawaz whose telephone number is (571) 272-3988. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*AMN*

AMN

  
SALEH NAJJAR  
SUPERVISORY PATENT EXAMINER